



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,691	07/20/2001	Lester E. Cornelius	65144/6	2552

7590

07/03/2003

Craig J. Arnold
Amster, Rothstein & Ebenstein
90 Park Avenue
New York, NY 10016

13
EXAMINER

FEELY, MICHAEL J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,691

Applicant(s)

CORNELIUS ET AL.

Examiner

Michael J Feely

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 47-64 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-46 is/are allowed.
- 6) ☒ Claim(s) 1-6, 21, 27 and 36 is/are rejected.
- 7) ☒ Claim(s) 7-20, 22-26 and 28-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-46 in Paper No. 12 is acknowledged.

Information Disclosure Statement

2. The information disclosure statement filed July 23, 2002 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

The following publications were listed incorrectly on form-1449: JP 61-230974 (Abstract), JP 61-230973 (Abstract), JP 62-059076 (Abstract), JP 5-328413 (application), and JP 6-267090 (application).

The three Japanese abstracts are not considered "Foreign Documents" and should have been listed under "Other Documents". The actual patent document is required to be considered as a "Foreign Document".

The two Japanese applications appear to be translation documents of Japanese applications. These translation documents are not considered "Foreign Documents" because they are not actual copies of the Japanese applications. These should have been listed under "Other Documents" rather than "Foreign Documents". If applicant were to submit the published versions of the Japanese applications, they would be classified as "Foreign Documents".

Priority

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate

Art Unit: 1712

support under 35 U.S.C. 112 for claims 1-46 of this application. The provisional application fails to even support the broadest embodiment of claim 1, wherein the ultraviolet block material has a transmittance of 10% or less for the light within a wavelength range of 300-380 nm and a transmittance of 90% or more for the light within a wavelength of 420-800 nm.

This application is also a continuation-in-part of prior Application No. 09/849,884, filed May 4, 2001. This application fails to provide adequate support for claims 1-46 of this application. The parent application fails to even support the broadest embodiment of claim 1, wherein the ultraviolet block material has a transmittance of 10% or less for the light within a wavelength range of 300-380 nm and a transmittance of 90% or more for the light within a wavelength of 420-800 nm. Hence, claims 1-46 do not receive a priority benefit from the parent application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 6 recite the limitation "the base material" in the ultraviolet block material according to claim 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

6. Claim 36 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

Art Unit: 1712

claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 36 attempts to further limit the article of claim 21, by reciting that the outer layer of the UV block layer or the outer "side" of the substrate is a layer *which receives color materials*. This is an example of a process limitation used to further limit and article claim; however, the process of *receiving color materials* is not necessarily required. The color materials are also not necessarily present on the article. A proposed change would include the language, -is a layer that *has received color materials*-.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

Art Unit: 1712

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-5, 21, 27, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshida (US Pat. No. 5,806,834).

Regarding claims 1-5, 21, 27, and 36, Yoshida discloses *(1)* an ultraviolet block material, characterized in that, a transmittance for the light within a wavelength range of 300-380 nm is 10% or less and a transmittance for the light within a wavelength range of 420-800 nm is 90% or more (column 4, lines 22-27; Figures 1 and 3); *(2)* wherein a transmittance for the light within a wavelength range of 300-390 nm is 10% or less (column 4, lines 22-27; Figures 1 and 3); *(3)* wherein a transmittance for the light within a wavelength range of 300-400 nm is 10% or less (column 4, lines 22-27; Figures 1 and 3); *(4)* wherein the ultraviolet block material contains an ultraviolet radiation absorber (column 8, lines 23-35) and a fluorescent material (column 10, lines 30-33); *(5)* wherein the ultraviolet radiation absorber is contained in an amount of 5-30% (column 8, lines 23-35); *(21)* wherein the ultraviolet block material has a substrate (column 10, lines 34-40) and an ultraviolet block layer adhered on the substrate (column 10, lines 34-40); and *(27)* wherein the ultraviolet block layer has a layer containing a fluorescent material (column 10, lines 30-33) and the layer containing the fluorescent material contains an ultraviolet radiation absorber (column 5, lines 49-57) and a stabilizer (column 8, lines 4-10).

Claim 36 fails to further limit claim 21 for the reasons set forth above in the *Claim Objections*; therefore, claim 36 is anticipated.

Regarding claim 27, Yoshida discloses the use of multiple UV absorbers. Applicants disclose on page 34, lines 8-9 of the Specification that an absorber can be used as a stabilizer. Yoshida uses a secondary absorber; therefore, in light of Applicants description of *stabilizers*, the reference reads on the limitations of the claim.

9. Claims 1, 4, and 5, are rejected under 35 U.S.C. 102(e) as being anticipated by Marien et al. (US Pat. No. 6,468,609).

Regarding claims 1, 4, and 5, Marien et al. disclose (1) an ultraviolet block material, characterized in that, a transmittance for the light within a wavelength range of 300-380 nm is 10% or less and a transmittance for the light within a wavelength range of 420-800 nm is 90% or more (column 2, lines 56-60; Table 1: comp. No. C-1 (5%) and comp. No. C-4 (5%)); (4) wherein the ultraviolet block material contains an ultraviolet radiation absorber (column 6, lines 45-49) and a fluorescent material (column 7, lines 62-65); and (5) wherein the ultraviolet radiation absorber is contained in an amount of 5-30% (column 6, lines 45-49).

Allowable Subject Matter

10. Claim 6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 7-20, 22-26, 28-35, and 37-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 44-46 are allowed.

Art Unit: 1712

13. The following is a statement of reasons for the indication of allowable subject matter: for all of the allowable claims, Yoshida (US 5,806,834) and Marien et al. (US Pat. No. 6,468,609) are the closest prior art. The following is a breakdown of allowable embodiments:

Claim 6: both Yoshida and Marien et al. use a fluorescent material; however, they are silent regarding quantity.

Claim 7 (and 8-20, 37, 38, 41, and 43): both Yoshida and Marien et al. apply their UV block material to polarizing plates; however, neither reference teaches or suggest the use of a releasable UV block material.

Claims 22 (and 23-26), 28 (and 31), 29 (and 35), 30, 32 (and 33), and 34: Yoshida teaches a laminate wherein UV block material is bonded on to a polarizing plate to form a two-layered laminate; however, they fail to teach or suggest a UV block material comprising a plurality of layers.

Claim 42: Yoshida fails to teach or suggest a method wherein the article of claim 36 is further laminated with a substrate paper.

Claim 39 (and 40): Yoshida fails to teach or suggest a method wherein the article of claim 21 is further laminated with another material.

Claim 44 and (45-46): both Yoshida and Marien et al. apply their UV block material to polarizing plates; however, neither reference teaches or suggests the use of a releasable UV block material.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schunk et al. (Pub. No. US 2003/0080326 A1) teach certain embodiments of the

Art Unit: 1712

instant invention; however, the earliest domestic priority date of the reference falls after the filing date of the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Feely whose telephone number is 703-305-0268. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Michael J. Feely
June 26, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700